

REMARKS

By the present communication, claim 11 has been amended to define Applicants' invention with greater particularity. No new matter is introduced by the subject amendments as the amended claim language is fully supported by the specification and original claims.

The amendments provided herewith are submitted to place the present application in condition for allowance, or, at a minimum, in better condition for appeal. Accordingly, entry of the amendments provided herewith is submitted to be proper; entry, therefore, is respectfully requested.

Upon entry of the amendments submitted herewith, claims 1-14, 21, and 24-26 remain pending in the application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination, is presented in the Listing of Claims, beginning on page 2 of this communication, with an appropriate status identifier for each claim.

Claim Rejections under 35 U.S.C. § 112 (1st Paragraph)

The withdrawal of the rejection of claims 1, 4-14, 21 and 24-26 under 35 U.S.C. § 112, first paragraph, is acknowledged with appreciation.

Claim Rejections under 35 U.S.C. § 112 (2nd Paragraph)

The withdrawal of the rejection of claims 1-14, 21 and 24-26 under 35 U.S.C. § 112, second paragraph, is acknowledged with appreciation.

The rejection of claim 12 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite, is once again respectfully traversed for at least the reasons of record. Specifically, Applicants respectfully disagree with the Examiner's assertion that there is insufficient antecedent basis in the claim for the limitation "R³ is -CH=CH-C(O)-O-tBu" (i.e., t-butoxycarbonyl-ethenyl) in the claim. Contrary to the Examiner's assertion, claim 12 properly depends on claim 11 (which requires that R³ is an alkenyl group). An "alkenyl" group, as defined at paragraph [0020] of the specification, is a hydrocarbyl group having at least 2 carbon

atoms and at least one carbon-carbon double bond. This definition clearly embraces ethenyl, which is simply a 2 carbon alkenyl. The presence of t-butoxycarbonyl-substitution on the ethenyl moiety (as contemplated by claim 12) does not change the fact that R³ is still an ethenyl moiety. Therefore, claim 12 is clearly within the scope of claim 11 from which it depends.

However, in efforts to reduce the issues and expedite prosecution, claim 11 has been amended herein substantially along the lines suggested by the Examiner (see page 3, lines 4-5 of the Office Action). The Examiner's suggestion of acceptable alternative claim language is acknowledged with appreciation.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejection.

Double Patenting

The withdrawal of the rejection of claims 1-14, 21, 24-26, 36, and 37 on the ground of nonstatutory obviousness-type double patenting is acknowledged with appreciation.

Claim Rejection under 35 U.S.C. § 102 (e)

The rejection of claims 1-14, 21 and 24-26 under 35 U.S.C. § 102(e), as allegedly being anticipated by Nicolau et al. (International Application No. WO 04/046162) is respectfully traversed for at least the reasons of record, i.e., the claims of the '162 application are directed only to compounds. Furthermore, the '162 application provides only minimal disclosure regarding potential uses of such compounds, see page 5, line 2-5. At most, according to the authors of the '162 application, the '162 application "may ultimately lead to compounds having utility in the treatment of disease linked to the accumulation of toxic bile acids." (page 30, lines 2 to 3; emphasis added). Thus, the '162 application is not enabling of the uses contemplated herein, therefore, the '162 application is not prior art against the claims of the present invention.

Even if the '162 application were enabling for treatment of the diseases contemplated by the present claims, the reference is still not properly applied against the present claims. Thus, as demonstrated by the attached declaration under 37 CFR 1.132, the present inventors were

in possession of the invention claimed herein prior to the earliest priority date to which the '162 publication may be entitled. Thus, the '162 application is not properly asserted against the present claims.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) are respectfully requested.

CONCLUSION

In view of the above amendments and remarks, Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

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Enclosure—Rule 132 declaration